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EXAMINER

HONEYCUTT, KRISTINA B

ART UNIT PAPER NUMBER

2178

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/961,308

Applicant(s)

DIRIENZO, ANDREW L.

Examiner

Kristina B. Honeycutt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-99 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-99 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/10/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: Response to Election/Restriction filed May 16, 2005.

This action is made **Non-Final**.

2. Claims 47-99 are elected in the case. Claims 47, 52, 88 and 90 are independent claims.

### *Information Disclosure Statement*

3. The information disclosure statement (IDS) was submitted on February 10, 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### *Drawings*

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- 360 in Figure 1,
- 370 in Figure 1,

- 360 in Figure 3,
- 370 in Figure 3,
- T3 in Figure 3.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 47, 51, 52, 57-66, 68, 70, 76, 79, 87, 88, 90, 93-97 and 99 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 47 recites the limitations "the file format" and "the data-accepting ones" in line 3,
- Claim 51 recites the limitation "the respective ones" in line 2,
- Claim 52 recites the limitations "the file format" and "the data-accepting ones" in line 4,
- Claim 57 recites the limitation "the sender" in line 5,
- Claim 58 recites the limitation "the sender" in line 3,
- Claim 59 recites the limitation "the specifications" in line 3,
- Claim 60 recites the limitation "the information system" in line 2,
- Claim 61 recites the limitations "the same fields" and "the same format" in line 4,
- Claim 62 recites the limitation "said ability" in line 1,
- Claim 63 recites the limitation "the sender" in line 1,
- Claim 64 recites the limitation "the sender" in line 1,
- Claim 65 recites the limitation "the sender" in line 2,
- Claim 66 recites the limitation "the sender" in line 2,
- Claim 68 recites the limitations "the sender" and "the Internet" in line 2,
- Claim 70 recites the limitation "the completed file" in line 1,
- Claim 76 recites the limitation "the sender" in line 2,
- Claim 79 recites the limitation "the second predetermined one" in line 4,
- Claim 87 recites the limitation "the user" in line 2,
- Claim 88 recites the limitation "the selected one" in line 6,

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- Claim 90 recites the limitations "the selected one" and "the members" in line 7,
- Claim 93 recites the limitation "the information system" in line 2,
- Claim 94 recites the limitation "the sender" in line 1,
- Claim 95 recites the limitation "the sender" in line 2,
- Claim 96 recites the limitation "the sender" in line 2,
- Claim 97 recites the limitations "the sender" and "the Internet" in line 2,
- Claim 99 recites the limitation "the user" in line 2.

There is insufficient antecedent basis for these limitations in the claims.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 47-99 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of claims 47-99 raises a question as to whether the claimed graphical user interfaces are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. §101.

See MPEP §2106 below.

## 2106 [R-2] Patentable Subject Matter – Computer-Related Inventions

### 1. Nonstatutory Subject Matter

If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *Schrader*, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

In practical terms, claims define nonstatutory processes if they:

- consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or
- simply manipulate abstract ideas, e.g., a bid (*Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (*Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application.

Cf. *Alappat*, 33 F.3d at 1543 n.19, 31 USPQ2d at 1556 n.19 in which the Federal Circuit recognized the confusion:

The Supreme Court has not been clear . . . as to whether such subject matter is excluded from the scope of 101 because it represents laws of nature, natural phenomena, or abstract ideas. See *Diehr*, 450 U.S. at 186 (viewed mathematical algorithm as a law of nature); *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972) (treated mathematical algorithm as an "idea"). The Supreme Court also has not been clear as to exactly what kind of mathematical subject matter may not be patented. The Supreme Court has used, among others, the terms "mathematical algorithm," "mathematical formula," and "mathematical equation" to describe types of mathematical subject matter not entitled to patent protection standing alone. The Supreme Court has not set forth, however, any consistent or clear explanation of what it intended by such terms or how these terms are related, if at all.

Certain mathematical algorithms have been held to be nonstatutory because they represent a mathematical definition of a law of nature or a natural phenomenon. For example, a mathematical algorithm representing the formula  $E = mc^2$  is a "law of nature" - it defines a "fundamental scientific truth" (i.e., the relationship between energy and mass). To comprehend how the law of nature relates to any object, one invariably has to perform certain steps (e.g., multiplying a number representing the mass of an object by the square of a number representing the speed of light). In such a case, a claimed process which consists solely of the steps that one must follow to solve the mathematical representation of  $E = mc^2$  is indistinguishable from the law of nature and would "preempt" the law of nature. A patent cannot be granted on such a process.

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data

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structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



7. Claims 47-50, 52, 53, 67-74, 79, 91 and 97 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 6, 8, 9, 10, 12, 13, 15, 16, 17, 19, 20, 23, 24, 26 of U.S. Patent No. 6343310 in view of Guzik et al. (U.S. Patent 6055333; date of patent April 25, 2000; filed December 28, 1995).

U.S. Patent No. 6343310 does not claim a sender and M recipients being greater than or equal to 2. Guzik teaches a sender and multiple recipients (col. 5, lines 29-35). It would have been obvious to combine U.S. Patent No. 6343310 with Guzik, because U.S. Patent No. 6343310 teaches files being transmitted to recipients and Guzik teaches files transmitted from a sender to multiple recipients (col. 5, lines 29-35).

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 47-54, 64-66, 72-75, 88-92, 94-96 and 98 are rejected under 35 U.S.C. 102(e) as being anticipated by Guzik et al. (U.S. Patent 6055333; date of patent April 25, 2000; filed December 28, 1995).

**Regarding independent claim 47**, Guzik discloses a graphical user interface (GUI) instantiated by computer software for generating a file from data entered into selected one of N fields in the GUI, wherein:

- at least one of the file format of the file and the data-accepting ones of the N fields is determined responsive to data entered into a first predetermined one of the N fields (col. 2, lines 20-32, 35-38; col. 4, lines 15-17 – as demonstrated in the cited text, the data-accepting fields is determined by data entered into a field); and
- N is an integer equal to or greater than 2 (col. 4, lines 15-17 – as demonstrated in the cited text, N is an integer equal or greater than 2).

**Regarding dependent claim 48**, Guzik discloses the GUI as recited in Claim 47, wherein:

- the data-accepting ones of the N fields are further limited responsive to data entered into a second predetermined one of the N fields (col. 4, lines 51-58 – as demonstrated in the cited text, the data-accepting fields are limited to data entered into a second field).

**Regarding dependent claim 49,** Guzik discloses the GUI as recited in Claim 47, wherein:

- a first portion of the data-accepting ones of the N fields is automatically filled in when the file is opened (col. 4, lines 57-58 – as demonstrated in the cited text, a first portion of the fields are filled in when opened since Guzik teaches fields being automatically filled in and the fields could be filled in when they are opened).

**Regarding dependent claim 50,** Guzik discloses the GUI as recited in Claim 47, wherein:

- a second portion of the data-accepting ones of the N fields is automatically filled in when data is entered into the first predetermined one of the N fields (col. 4, lines 51-58 – as demonstrated in the cited text, a second portion is automatically filled in when data is entered into a first field).

**Regarding dependent claim 51,** Guzik discloses the GUI as recited in Claim 47, wherein:

- each of the N fields has an associated label identifying specific information to be inserted into the respective one of the N fields (col. 4, lines 34-40 – as demonstrated in the cited text, the fields have labels identifying information to be inserted into them).

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**Regarding independent claim 52**, Guzik discloses a graphical user interface (GUI) instantiated by computer software for generating a file transmittable to a selected one of M recipients from data entered into selected one of N fields in the GUI, wherein:

- at least one of the file format of the file and the data-accepting ones of the N fields is determined responsive to data entered into a first predetermined one of the N fields (col. 2, lines 20-32, 35-38; col. 4, lines 15-17 – as demonstrated in the cited text, the data-accepting fields is determined by data entered into a field); and
- M and N are integers equal to or greater than 2 (col. 4, lines 15-17; col. 5, lines 29-35 – as demonstrated in the cited text, M and N are integers equal or greater than 2).

**Regarding dependent claim 53**, Guzik discloses the GUI as recited in Claim 52, wherein:

- the selected one of the M recipients is selected by entering an unique identifier corresponding to the selected one of the M recipients into a first predetermined one of the N fields (col. 5, lines 29-35 – as demonstrated in the cited text, a recipient is identified since Guzik teaches transmitting to a specific recipient so the recipient must be identified in order for a transmission to occur).

**Regarding dependent claim 54**, Guzik discloses the GUI as recited in Claim 52, wherein:

- each of the M recipients has associated therewith a unique portion of the instantiating software (col. 2, lines 20-28 – as demonstrated in the cited text, the software is associated with the recipients).

**Regarding dependent claim 64,** Guzik discloses the GUI as recited in Claim 52, wherein:

- the M recipients and the sender operate independent computer systems (col. 1, lines 62-67; col. 5, lines 29-35 – as demonstrated in the cited text, the recipient and the sender operate different computers).

**Regarding dependent claim 65,** Guzik discloses the GUI as recited in Claim 52, wherein:

- the GUI provides a single universal interface between the sender and the M recipients (col. 2, lines 53-60 – as demonstrated in the cited text, the GUI provides a single universal interface).

**Regarding dependent claim 66,** Guzik discloses the GUI as recited in Claim 52, wherein:

- the instantiating computer software resides on a personal computer operated by the sender (Fig. 1; col. 1, lines 62-67 – as demonstrated in the figure and cited text, the software resides on a personal computer).

**Regarding dependent claims 72, 73 and 74**, the claims reflect the GUI for performing the operations of claims 49, 50 and 48 respectively and are rejected along the same rationale.

**Regarding dependent claim 75**, Guzik discloses the GUI as recited in Claim 52, wherein:

- the fields are blank labeled fields asking for specific information (col. 4, lines 34-40, 51-58 – as demonstrated in the cited text, the fields ask for specific information).

**Regarding independent claim 88**, Guzik discloses a graphical user interface (GUI) instantiated by computer software for generating a file in one of a plurality of formats from data entered into the GUI, the GUI comprising:

- N data-accepting fields disposed in a predetermined order including an active subset of the N data-accepting fields and an inactive subset of the N data-accepting fields (col. 4, lines 51-58 – as demonstrated in the cited text, active and inactive fields are present);
- at least one of the selected one of the formats and members of the active subset and is determined responsive to data entered into a first one of the N data-accepting fields (col. 2, lines 20-32, 35-38; col. 4, lines 15-17 – as demonstrated in the cited text, the data-accepting fields are determined by data entered into a field); and

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- N is an integer equal to or greater than 2 (col. 4, lines 15-17 – as demonstrated in the cited text, N is an integer equal or greater than 2).

**Regarding dependent claim 89,** Guzik discloses the GUI as recited in Claim 88,

wherein:

- the members of the active subset of the N data-accepting fields are further limited responsive to data entered into a second one of the N data-accepting fields included in the active subset (col. 4, lines 51-58 – as demonstrated in the cited text, the active data-accepting fields are limited to data entered into a second field).

**Regarding claims 90, 91, 92, 94, 95, 96 and 98,** the claims reflect the GUI for performing the operations of claims 88, 53, 54, 64, 65, 66 and 89 respectively and are rejected along the same rationale.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 55, 56, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guzik in view of Rossmann (U.S. Patent 6625447; date of patent September 23, 2003; filed November 24, 1998; continuation filed December 11, 1995).

**Regarding dependent claim 55**, Guzik does not disclose the unique portion of the instantiating software associated with each of the M recipients contains information specifying which of the N fields presented by the GUI will accept data in files generated for transmission to that recipient. Rossmann teaches specifying which fields will accept data for that recipient (col. 26, lines 1-10). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Rossmann before him at the time the invention was made, to modify the GUI taught by Guzik to include specifying which fields will accept data as taught by Rossmann, because specifying the fields that will accept data for a recipient, as taught by Rossmann (col. 26, lines 1-10), would allow users to distinguish the fields that needed to be filled in for a particular recipient from those fields that the recipient does not accept.

**Regarding dependent claim 56**, Guzik does not disclose the unique portion of the instantiating software associated with each of the M recipients contains information specifying the format to be used for files generated for transmission to that recipient. Rossmann teaches specifying the format for that recipient (col. 26, lines 1-10). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Rossmann before him at the time the invention was made, to modify the GUI taught by



Guzik to include specifying the format as taught by Rossmann, because specifying the format for a recipient, as taught by Rossmann (col. 26, lines 1-10), would allow users to distinguish the format that a recipient would accept from those that the recipient does not accept.

**Regarding dependent claim 59,** Guzik discloses selecting a recipient and a unique portion of the instantiating software is associated with the recipient (col. 2, lines 20-28; col. 5, lines 29-35) but does not disclose the data-accepting ones of the N fields presented by the GUI and the format of the file generated are determined responsive to the specifications. Rossmann teaches specifying the fields that accept data and the format for that recipient (col. 26, lines 1-10). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Rossmann before him at the time the invention was made, to modify selecting a recipient and associating software with that recipient as taught by Guzik to include specifying the fields that accept data and the format as taught by Rossmann, because specifying the fields that accept data and the format for a recipient, as taught by Rossmann (col. 26, lines 1-10), would allow users to distinguish the data-accepting fields and the format for a recipient from those that the recipient does not accept.

10. Claims 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guzik in view of Cauffman et al. (U.S. Patent 5325290; date of patent June 28, 1994; filed October 25, 1991).

**Regarding dependent claims 57 and 58,** Guzik does not disclose the unique portion of the instantiating software associated with each of the M recipients is accessed and updated as the file requirements of that particular recipient changes; independent of the other M recipients; and independent of the sender of the transmitted file. Cauffman teaches updating as file requirements change, independent of other users or the sender (col. 27, lines 20-25). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Cauffman before him at the time the invention was made, to modify the GUI taught by Guzik to include updating the software as taught by Cauffman, because updating as file requirements change, independent of the other recipients or sender, as taught by Cauffman (col. 27, lines 20-25), would allow users to have up-to-date software that is compatible with the recipients.

11. Claims 60-63, 68-71, 93 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guzik in view of Loveria, III (U.S. Pub. No. 20040090466; publication date May 13, 2004; filed July 15, 2003; continuation filed July 20, 1994).

**Regarding dependent claim 60,** Guzik does not disclose the transmittable file generated can be digitally integrated directly into the information system of the selected one of the M recipients. Loveria teaches a transmitted file being digitally integrated into a system of a recipient (p.1, para. 6). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Loveria before him at the time the invention

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was made, to modify the transmittable file taught by Guzik to include the file being digitally integrated as taught by Loveria, because digitally integrating the transmittable file into a recipient's system, as taught by Loveria (p.1, para. 6), would allow recipients to have the file in their computer systems for further use.

**Regarding dependent claim 61,** Guzik does not disclose the transmittable file generated can be integrated digitally into the information system of the selected one of the M recipients without imposing a standard on the transmittable file which forces every one of the M recipients to accept files with the same fields which accept data and the same format as files generated for all the other M recipients. Loveria teaches a transmitted file being digitally integrated into a system of a recipient without imposing standards (p.1, para. 6). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Loveria before him at the time the invention was made, to modify the transmittable file taught by Guzik to include the file being digitally integrated without imposing standards as taught by Loveria, because digitally integrating the transmittable file into a recipient's system without imposing standards, as taught by Loveria (p.1, para. 6), would allow one recipient to have the file in his/her computer system for further use without imposing the file on the other recipients computer systems.

**Regarding dependent claim 62,** Guzik does not disclose said ability to directly integrate the transmitted file into the information system of the selected one of the M

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recipients is maintained even when the instantiating software is updated. Loveria teaches the ability to integrate a transmitted file being maintained (p.1, para. 6). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Loveria before him at the time the invention was made, to modify the transmittable file taught by Guzik to include the ability to integrate a transmitted file as taught by Loveria, because maintaining the ability to digitally integrate the transmittable file into a recipient's system, as taught by Loveria (p.1, para. 6), would allow users to transmit files which are integrated into the recipients' computers despite the version of the instantiating software that was being utilized.

**Regarding dependent claim 63,** Guzik does not disclose the sender can generate a file which can be digitally integrated directly into the information system of the selected one of the M recipients without said recipient divulging to the sender specifications of its information system. Loveria teaches digitally integrating files without the recipient divulging specifications (p.1, para. 6). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Loveria before him at the time the invention was made, to modify the transmittable file taught by Guzik to include digitally integrating without the recipient divulging specifications as taught by Loveria, because digitally integrating the transmitted file without the recipient divulging specifications, as taught by Loveria (p.1, para. 6), would allow users to transmit files to recipients that could be digitally integrated into the recipients' computer systems without the recipients having to send specifications to the users.

**Regarding dependent claim 68,** Guzik does not disclose the instantiating computer software resides on a server computer accessible to the sender via the Internet.

Loveria teaches residing on a server accessible via the Internet (p.1, para. 3). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Loveria before him at the time the invention was made, to modify the software taught by Guzik to include residing on a server accessible via the Internet as taught by Loveria, because a server accessible via the Internet, as taught by Loveria (p.1, para. 3), would allow users to send and receive information from any location that is Internet accessible.

**Regarding dependent claim 69,** Guzik does not disclose the file generated is transmitted from the server to the selected one of the M recipients. Loveria teaches a file transmitted from the server to the recipient (p.1, para. 3). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Loveria before him at the time the invention was made, to modify the generated file taught by Guzik to include transmitting the file from the server to the recipient as taught by Loveria, because transmitting the file from the server to the recipient, as taught by Loveria (p.1, para. 3), would allow files to be sent to specific recipients.

**Regarding dependent claim 70,** Guzik does not disclose the completed file is archived on a computer permitting access to the server. Loveria teaches a completed file archived on a computer (p.5, para. 35). It would have been obvious to one of ordinary

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skill in the art, having the teachings of Guzik and Loveria before him at the time the invention was made, to modify the GUI taught by Guzik to include archiving the file as taught by Loveria, because archiving the file, as taught by Loveria (p.5, para. 35), would allow users to store the file for later use.

**Regarding dependent claim 71,** Guzik does not disclose the file is completed on the server; the completed file is downloaded to the accessing computer; and the completed file is transmitted to the chosen one of the M recipients from the accessing computer. Loveria teaches a file completed on the server, downloading the file and transmitting the file to a recipient (p.1, para. 3; p.5, para. 35). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Loveria before him at the time the invention was made, to modify the GUI taught by Guzik to include completing, downloading and transmitting the file as taught by Loveria, because completing, downloading and transmitting the file, as taught by Loveria (p.1, para. 3; p.5, para. 35), would allow users to utilize the server to access and modify files and then send the files to other users.

**Regarding claims 93 and 97,** the claims reflect the GUI for performing the operations of claims 60 and 68 respectively and are rejected along the same rationale.

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12. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guzik in view of Aldrich et al. (U.S. Patent 5138698; date of patent August 11, 1992; filed February 19, 1991).

**Regarding dependent claim 67,** Guzik does not disclose the instantiating computer software is automatically updated whenever the file is transmitted to the one of the M recipients. Aldrich teaches updating when a file is transmitted (col. 14, lines 52-55). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Aldrich before him at the time the invention was made, to modify instantiating computer software taught by Guzik to include updating the software as taught by Aldrich, because updating the software whenever a file is transmitted, as taught by Aldrich (col. 14, lines 52-55), would allow users to have up-to-date software capable of interacting with recipients.

13. Claims 76-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guzik in view of Goltra (U.S. Patent 5802495; date of patent September 1, 1998; filed March 1, 1996).

**Regarding dependent claim 76,** Guzik discloses the generated file generated is a transaction form to be transmitted from the sender to a selected one of the M recipients (col. 4, lines 54-67; col. 5, lines 29-35).

**Regarding dependent claim 77,** Guzik does not disclose the generated file corresponds to one of a bill and a claim for services from a healthcare provider to a healthcare care payer. Goltra teaches a bill from a healthcare provider to a healthcare payer (col. 1, lines 51-64). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Goltra before him at the time the invention was made, to modify the form taught by Guzik to include a bill as taught by Goltra, because the file corresponding to a bill from a provider to a payer, as taught by Goltra (col. 1, lines 51-64), would allow the invention to be utilized in various fields, including medical areas.

**Regarding dependent claim 78,** Guzik does not disclose at least one of the data-accepting fields accept an insurance claim form attachment. Goltra teaches an insurance claim (col. 1, lines 51-64). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Goltra before him at the time the invention was made, to modify the form taught by Guzik to include a insurance claim as taught by Goltra, because the bill including an insurance claim, as taught by Goltra (col. 1, lines 51-64), would allow the invention to be utilized in various fields, including medical areas.

**Regarding dependent claim 79,** Guzik discloses the first predetermined one of the N fields accepts an unique identifier associated with a payer and the second predetermined one of the N fields accepts a code associated with a unique medical service (col. 4, lines 51-67).



**Regarding dependent claim 80**, Guzik discloses once the first and second predetermined fields have been populated with respective data, the remaining fields identify additional data the payer requires to support the claim for the specified medical service (col. 4, lines 51-67).

14. Claims 81-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guzik in view of Laszlo (U.S. Patent 5331547; date of patent July 19, 1994; filed January 29, 1993).

**Regarding dependent claims 81-86**, Guzik does not disclose at least one of the data-accepting fields accepts a computer file, a digital image, a word processor document, a digital graph, a digital sound recording or a digitized video signal. Laszlo teaches a computer file, an image, a document, a graph, a sound recording or a video (col. 2, lines 45-52). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik and Laszlo before him at the time the invention was made, to modify the data-accepting fields taught by Guzik to accept a computer file, a digital image, a word processor document, a digital graph, a digital sound recording and a digitized video signal as taught by Laszlo, because Laszlo teaches similarities between the above mentioned (col. 2, lines 45-52) so it would have been beneficial to a user for the fields to accept them as input.

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15. Claims 87 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guzik in view of Rossmann in further view of Loveria.

**Regarding dependent claim 87,** Guzik discloses files generated during sessions by the users but does not disclose formats or integration of the files into the information systems operated by the recipients. Rossmann teaches specifying the format (col. 26, lines 1-10) and Loveria teaches integrating a file into a system (p.1, para. 6). It would have been obvious to one of ordinary skill in the art, having the teachings of Guzik, Rossmann and Loveria before him at the time the invention was made, to modify selecting generating files as taught by Guzik to include specifying formats as taught by Rossmann and integrating files as taught by Loveria, because specifying formats, as taught by Rossmann (col. 26, lines 1-10) and integrating files, as taught by Loveria (p.1, para. 6), would allow recipients to receive files in the correct format that could be integrated into their computer systems.

**Regarding dependent claim 99,** the claim reflects the GUI for performing the operations of claim 87 and is rejected along the same rationale.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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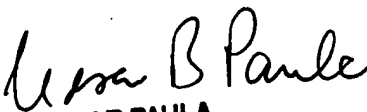
- Label generating and data tracking system for processing purchase order (U.S. Patent 5315508).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristina B. Honeycutt whose telephone number is 571-272-4123. The examiner can normally be reached on 8:00 am - 5:00 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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